

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

In re Truth Partners LLC, dba Mid State Fabricating

Serial No. 88944166

Kristine M. Young and Daniel P. Virtue, of Mayer Brown LLP,
for Truth Partners LLC.

Sarah Valenti, Trademark Examining Attorney, Law Office 112,
Mark Pilaro, Managing Attorney.

Before Wolfson, Adlin and Hudis, Administrative Trademark Judges.

Opinion by Wolfson, Administrative Trademark Judge:

Applicant, Truth Partners LLC, seeks registration of the mark shown below:



Serial No. 88944166

for “Metal fabrication and finishing services for others; Machine shop services, namely, machining parts for others” in International Class 40.¹

The Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that Applicant’s mark so resembles the registered mark shown below:



for, *inter alia*,

Common metals and their alloys, in International Class 6;

Milling machines and grinding machines for treatment of metal, for forming, riveting, swaging and flaring of metal, in International Class 7;

Treatment of materials, namely, treatment of metals, treatment of plastic, treatment of fabrics; custom manufacture and assembly services, namely providing plans for others in the metal sector; treatment and conversion of metal; rental of objects in connection with the providing of the aforesaid services, included in this class, namely, rental of machines and machine tools for milling, grinding and treatment of metals; consultancy and information in

¹ Application Serial No. 88944166 was filed on June 2, 2020 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), asserting Applicant’s bona fide intent to use the mark in commerce. The application includes the following description of the mark: “The mark consists of the letters ‘MW’ within a broken hexagon with the right stem of the letter ‘M’ forming the right half of the hexagon and the left stem of the letter ‘W’ forming the left half of the hexagon.”

relation to the aforesaid services, included in this class namely, in the field of the treatment of metals; printing, in International Class 40, and

Development of new materials, automation and testing technologies, in International Class 42,²

that use of Applicant's mark in connection with Applicant's services is likely to cause confusion. After the refusal became final, Applicant appealed and filed a Request for Reconsideration. After the Request for Reconsideration was denied, the appeal resumed. The case has been fully briefed. We affirm.

I. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper*

² Registration No. 5706050 issued on March 26, 2019 under Section 66(a) of the Trademark Act, 15 U.S.C. § 1141f(a), with a priority date of November 3, 2017, derived from International Reg. No. 1401309. The cited registration also includes the following description of the mark: “The mark consists of the stylized letters ‘MW’ on top of each other surrounded by a circle with a horizontal line between the two letters.”

Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. The Marks

The respective marks are quite similar “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). The only cognizable distinction between the marks is the differing stylization of the identical lettering and the differing background designs surrounding and incorporating the letters MW. These distinctions do not serve to produce a meaningful difference between them.

Although we agree with Applicant that “it is improper to dissect a mark,” 6 TTABVUE 9,³ we also agree with Applicant that: “there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety.” *Id.* at 9-10 (citing *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). Greater weight is often given to a mark’s dominant feature when determining whether marks are confusingly similar. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1050

³ Citations to the briefs are to the Board’s online database TTABVUE. Before the TTABVUE designation is the docket entry number; and after this designation are the page references, if applicable. Citations to the examination record refer to the USPTO’s online Trademark Status and Document Retrieval system (TSDR).

(Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)). Here, the letters MW are the dominant portions of both marks for several reasons.

First, “MW” is the only pronounceable portion of each mark. Similarity in sound alone may be sufficient to support a finding that the marks are confusingly similar. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (CCPA 1968)). Second, the literal element of each mark, “MW,” is more likely than the design features to be impressed upon a purchaser’s memory and to “be used by consumers to request the goods [or services].” *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); *see also In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (“In the case of a composite mark containing both words and a design, ‘the verbal portion of the mark is the one most likely to indicate the origin of the goods [or services] to which it is affixed.’”) (quoting *CBS Inc. v. Morrow*, 708 F. 2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir 1983)).

Third, the stylization of the lettering in each mark is not so unique or unusual that it adds any meaningful distinctiveness to either mark. Neither portrayal is so striking that it creates “a separate and inherently distinctive commercial impression apart from [MW] itself.” *In re Sadoru Group, Ltd.*, 105 USPQ2d 1484, 1485 (TTAB 2012) (internal citations omitted); *see also In re AC Webconnecting Holding B.V.*, 2020 USPQ2d 11048, *14 (TTAB 2020) (presentation of proposed mark  “does

not possess the degree of stylization that would warrant allowance on the Supplemental Register”).

Finally, the circular and hexagonal design elements of each mark are essentially ordinary geometric shapes that serve as mere background for the lettering. *See, e.g., B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1508 n.23 (TTAB 2007) (“plain geometric designs” are not seen by consumers as particularly distinctive); *In re Benetton Grp. S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998) (“In particular, common geometric shapes such as circles, squares, rectangles, triangles and ovals, when used as backgrounds for the display of word marks, are not regarded as trademarks for the goods to which they are applied absent evidence of distinctiveness of the background design alone.”).

Contrary to Applicant’s argument, 6 TTABVUE 15, the fact that the letters MW are visually incorporated into the overall design of each mark does not render the marks distinguishable. “The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties.” *Zheng Cai v. Diamond Hong, Inc.*, 901 F. 3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018); *see also In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017); *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (marks “must be considered . . . in light of the fallibility of memory” and “not on the basis of side-by-side comparison.”) (quoting *San*

Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp., 565 F.2d 683, 685 (CCPA 1977)).

Applicant argues that the cited mark is weak because there are “numerous third-party applications and registrations for MW-formative marks in class 40 claiming services similar or related to those claimed by the Applicant and the Registrant.” 6 TTABVUE 19.⁴ This argument is unavailing. First, unlike third-party registrations, third-party applications such as those Applicant submitted are evidence only of the fact that they have been filed. *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463, 1468 n.6 (TTAB 2003). And absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them.⁵ *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA

⁴ Applicant further argues that the “lack of any likelihood of confusion is also evidenced by the fact that the Marks have co-existed without actual confusion since at least 2020.” 6 TTABVUE 8. There is no evidence in support of Applicant’s argument, and “uncorroborated statements of no known instances of actual confusion are of little evidentiary value.” *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any event, even if the marks have coexisted without actual confusion since sometime in 2020, that is just a little over one year and Applicant has failed to show its sales and advertising activities, if any, have been so appreciable (particularly in light of the fact that during the past two years, the economy has been largely shut down due to the pandemic) “so that, if confusion were likely to occur, circumstances have been such that it could be expected to have happened.” *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

⁵ Applicant also argues that the “Cited Registration also co-exists alongside various uses of MW-formative marks in connection with manufacturing services.” 6 TTABVUE 8. Again, there is no evidence to support Applicant’s argument and “[party] argument is no substitute for evidence.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 76 USPQ2d 1616, 1622 (Fed. Cir. 2005)).

1973) (the purchasing public is not aware of registrations reposing in the U.S. Patent and Trademark Office); *Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011).

However, “third-party registrations are relevant evidence of the inherent or conceptual strength of a mark or term because they are probative of how terms are used in connection with the goods or services identified in the registrations.” *In re Morinaga Nyugyo Kabushiki Kaisha*, 120 USPQ2d 1738, 1745 (TTAB 2016). But in this case, the services recited in the third-party registrations are dissimilar and unrelated to Applicant’s services. Of the eleven registrations Applicant submitted, five of them cover dry-cleaning services or tailoring and clothing alterations services. The remaining registrations, listed below, are for visually dissimilar marks for treatment or custom manufacture of unrelated, non-metal goods:⁶

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MARK WILKINSON
ENGLAND, Reg. No. 5372175, for, *inter alia*, “Custom fitting of cupboards, wardrobes, drawers, dressers, bookcases and larders;”

⁶ To the extent the services of Reg. No. 4921679 or Reg. No. 5533659 may include the manufacture of metal hydraulic products or metal material handling equipment, the existence of these two third-party marks does not change our finding regarding the strength of the registered mark. The existence of two third-party registrations is far too few in number to establish that the cited mark is relatively weak and entitled only to a limited protection. *See, e.g., Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1673 n.1 (Fed. Cir. 2015) (at least twenty-six relevant third party uses or registrations made of record).

-  , Reg. No. 4754533 for “Custom manufacture of new products in the nature of consumer electronics, non-metal construction material, clocks, rayon fabric, fabric, cloth, shoes, sneakers, disposable drinking vessels, beverage containers, aeronautical equipment, furniture, stationery, artificial resins, cases for electronic devices, and sunglasses using recycled materials;”
-  , Reg. No. 4921679 for “Manufacture of hydraulic products, hoses, belts, and related fittings for use in the oil and gas industry and general industrial applications to order and/or specification of others;”
-  MONROE WORKSHOP , Reg. No. 4604790 for “Furniture; Manufacture of furniture to order and/or specification of others;”
-  , Reg. No. 5533659 for “Custom manufacturing of material handling equipment, namely, belt, roller, trolley, wheel, slat, pan, chain and track conveyors;” and
-  , Reg. No. 1604964 for “Waste disposal service; Waste treatment and recycling services.”

Accordingly, the third-party registrations Applicant made of record have little probative value. *See, e.g., Tao Licensing, LLC v. Bender Consulting Ltd. d/b/a Asian Pac. Beverages*, 125 USPQ2d 1043, 1058 (TTAB 2017) (“Such registrations have no

bearing on the strength of the term in the context relevant to this case.”) (citing *In re i.am.symbolic*, 123 USPQ2d at 1751 (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration)); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639 (TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue).

The “MW” element of both Applicant’s and Registrant’s marks is an arbitrary combination of letters in relation to metal fabrication and treatment of metals, and has no significance or meaning which would aid purchasers in distinguishing source. Indeed, “arbitrary arrangements of letters are generally given a wide scope of protection because they are more difficult to remember than word marks. Thus, when multiple-letter marks are similar, the difficulty of remembering them makes the likelihood of confusion between them more probable.” *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-Int’l GmbH*, 230 USPQ 530, 535 (TTAB 1986) (confusion found

likely in contemporaneous use of  (EB and design) for all purpose gym bags

and certain clothing items and  (EBS and design) for shoes); *Chemetron Corp. v. N.R.G. Fuels Corp.*, 157 USPQ 111, 113 (TTAB 1968) (confusion found likely in contemporaneous use of NCG “per se or in combination with various design elements”

for compressed gases and  (NRG and design) for liquefied petroleum gas, etc.).

Applicant's and Registrant's marks are similar in appearance, and identical in pronunciation and meaning. Their commercial impression is highly similar because they both prominently display the dominant term "MW" against a circular or hexagonal background carrier design. The first *DuPont* factor strongly favors a finding of likelihood of confusion.

B. The Services

The second *DuPont* factor "considers '[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration.'" *In re Detroit Athletic*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567). Therefore, we must make our determination based on the goods and services as they are identified in the application at issue and cited registration. *See Stone Lion Cap. Partners, L.P. v. Lion Cap. LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Dixie Rests.*, 41 USPQ2d at 1534; *Octocom Sys., Inc. v. Houston Comput. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

The services need not be identical or even competitive to find a likelihood of confusion; they need only be related. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080 , 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322 , 54 USPQ2d 1894, 1898 (Fed. Cir. 2000). It is sufficient for a finding of likelihood of confusion as to a particular class if relatedness is established for any item of identified goods or services within that class in the application. *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335 , 209 USPQ 986, 988 (CCPA 1981); *see also Hewlett-Packard*, 62 USPQ2d at 1005.

The services recited in the application are “Metal fabrication and finishing services for others; machine shop services, namely, machining parts for others.” The recited services in the cited registration include services in Class 40: “Treatment of materials, namely, treatment of metals;” “treatment and conversion of metal;” and “rental of machines and machine tools for milling, grinding and treatment of metals.”

Where services are broadly identified, as they are here, they are deemed to encompass all of the services of the nature and type described. *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015); *In re Hughes Furniture Indus., Inc.*, 114 USPQ2d 1134, 1137 (TTAB 2015). Registrant’s broadly identified “treatment and conversion of metals” necessarily includes Applicant’s “metal fabrication and finishing services for others.” The Class 40 services therefore are legally identical in part, a factor that weighs in favor of a finding of likelihood of confusion. *See In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010); *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008) (“The identity, at least in part, between applicant’s and registrant’s [services] is a factor that weighs heavily against applicant in the likelihood of confusion analysis.”). Similarly, Registrant’s “milling and grinding machines for treatment of metal” are complementary to Applicant’s machine shop services, as Applicant acknowledges. 9 TTABVUE 7 (“While complementary in nature, these [goods and] services are not ‘virtually identical.’”).

Based on this evidence, we find that the recited goods and services in the application and cited registration are legally identical in-part and otherwise

closely related. The second *DuPont* factor therefore also heavily favors a finding of likelihood of confusion.

C. Channels of Trade

We first consider the legally identical services in the application and the cited registration. As to these services, “they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.” *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994); *see also In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical [services], the channels of trade and classes of purchasers are considered to be the same); *Am. Lebanese Syrian Associated Charities Inc. v. Child Health Research Inst.*, 101 USPQ2d 1022, 1028 (TTAB 2011). *See also In re Viterra*, 101 USPQ2d at 1908 (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

With respect to the closely related goods and services, neither Applicant’s recitation of services nor Registrant’s identification of goods and services contains any limitations regarding their channels of trade or the consumers to whom the goods and services are marketed. Accordingly, Applicant’s and Registrant’s goods and services are presumed to be suitable for any use that is normal therefor, and also to move in all normal channels of trade and be available to all classes of potential consumers. *Stone Lion*, 110 USPQ2d at 1161; *see also Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012) (absent limitation,

“goods [and services] are presumed to travel in all normal channels ... for the relevant goods [and services].”).

Applicant argues, based on information displayed on Registrant’s website, that:

Here, Applicant’s Services are marketed to individuals and businesses seeking the fabrication of precision prototypes and production of machined metals with precise details and materials, whereas the Registered Services are offered to only industrial design professionals, including those who designed and built the CERN particle accelerator ... which involves significant financial commitments, investigation, research and care.⁷

However, we may not limit or restrict the goods or services in the cited registration based on extrinsic evidence. *In re Midwest Gaming & Ent. LLC*, 106 USPQ2d 1163, 1165 (TTAB 2013), *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008), *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) (“the question of likelihood of confusion must be determined by an analysis of the marks as applied to the goods [or services] identified in the application vis-à-vis the goods [or services] recited in the registration, rather than what extrinsic evidence shows those goods [or services] to be.”). It is thus immaterial, even if true, that Registrant’s goods or services may be offered only to industrial design professionals.

The third *DuPont* factor, channels of trade, also favors a finding of likelihood of confusion, heavily so with respect to the legally identical services.

⁷ August 25, 2021 Request for Reconsideration, TSDR 5; website pages at <https://www.mannesmann-stainless-tubes.com/markets/power-gen/nuclear-sciences>, *Id.*, TSDR 10-15.

D. Purchaser Sophistication

Applicant argues that likelihood of confusion is eliminated “due to the sophistication of the purchasers, coupled with the high cost of investment into the parties’ respective services[.]” 6 TTABVUE 8. Applicant maintains that “both parties appeal to consumers who are discerning and typically invest time to identify the service provider of choice, who are not easily misled [sic] or confused.” 6 TTABVUE 18. Applicant supports its arguments with the information discussed above from Registrant’s website.

As we noted above, letter marks are more susceptible to confusion because letter combinations are likely to be inherently difficult to remember. *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1509 (TTAB 2007); *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1597 (TTAB 1990). Even careful purchasers are likely to be confused by highly similar marks used in connection with legally identical or closely related services. “Confusion of letter combinations is a concern even when the prospective purchasers of the goods are sophisticated purchasers.” *B.V.D. Licensing*, 83 USPQ2d at 1509. As stated by our primary reviewing court, “[t]hat the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods [or services]. ‘Human memories even of discriminating purchasers ... are not infallible.’” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986), quoting *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970).

Thus, even if we accept, in considering the fourth *DuPont* factor, Applicant's unsupported assertion that the involved services may be the subject of sophisticated purchases, we still would find confusion likely.

The fourth *DuPont* factor, customer sophistication, is neutral or slightly favors Applicant.

II. Summary and Conclusion

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. We find that the marks are highly similar in appearance, and identical in pronunciation, connotation, and overall commercial impression. Registrant's mark is entitled to no less than the normal scope of protection accorded to any inherently distinctive mark. Applicant's services and Registrant's goods and services are in-part identical and otherwise closely related and sold in overlapping channels of trade to overlapping consumers. To the extent the degree of consumer sophistication and care may be heightened, this does not rise to a level that outweighs the other factors.

On balance, we find these factors render confusion likely.

Decision: The refusal to register Applicant's mark  under Section 2(d) of the Trademark Act is affirmed.